



7-1-03

1634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: CHAPARIAN, ET. AL.

Serial No.: 10/049,994

Group Art Unit: 1634

Filed: February 18, 2002

Examiner: SWITZER, Juliet Caroline

For: GENE CLONING

Attorney Docket No.: 1002.00011

**RESPONSE**

Mail Stop Sequence Listing  
Commissioner for Patents  
PO BOX 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated June 3, 2003. Restriction to one of the following Groups was required under 35 USC §121:

- I. Claims 1-4, 7-9, and 15-16, drawn to a method of cloning.
- II. Claims 5-6, drawn to a primer.
- III. Claims 10-11, 12-13, 14, and 17-18, drawn to genes and a library of said genes.

Applicants provisionally elect Group I, claims 1-4, 7-9, and 15-16 for prosecution purposes, with traverse. Applicants hereby conditionally withdraw claims 5-6, 10-14, and 17-18 from prosecution, without prejudice, and request reconsideration of the restriction requirement.

Applicants traverse the restriction requirement based on the following grounds. It is respectfully submitted that the restriction requirement practice was established to promote efficiency of prosecution in the Patent Office. All of the groups related to clonings and items used for cloning. Hence, it is respectfully submitted that restriction

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should not be required and that Applicants have traversed the restriction requirement. However, as stated above, Applicants have elected the claims of Group I and provisionally withdrawn claims 5-6, 10-14, and 17-18, without prejudice, pending reconsideration of the restriction requirement.

The Office Action has stated that the present application does not comply with 37 CFR 1.821-25 in that there are sequences within the specification without the appropriate sequence listing. Accordingly, an appropriate sequence listing is included herewith along with the appropriate computer readable copy and a letter stating that the content of the paper and the computer readable copies are identical.

The application is now in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



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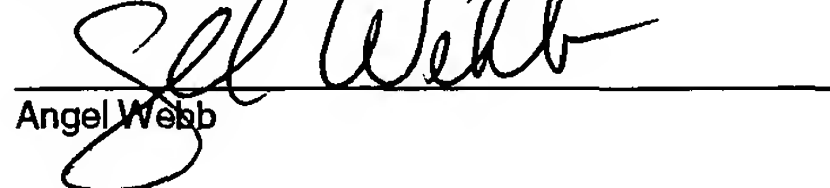
(248) 539-5050

Dated: June 30, 2003

**CERTIFICATE OF MAILING**

EXPRESS MAIL LABEL: EV33883520US

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" addressed to the Mail Stop Sequence, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 30, 2003.

  
Angel Webb

Restriction/Election  
7-3-03



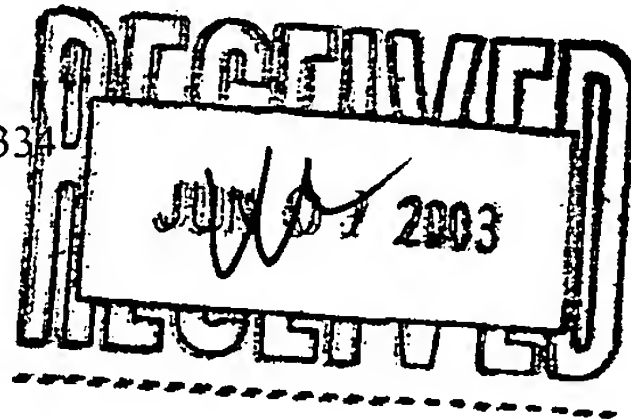
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,994	02/18/2002	Michael G. Chaparian	1002.00011	2607



7590 06/03/2003  
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EXAMINER

SWITZER, JULIET CAROLINE

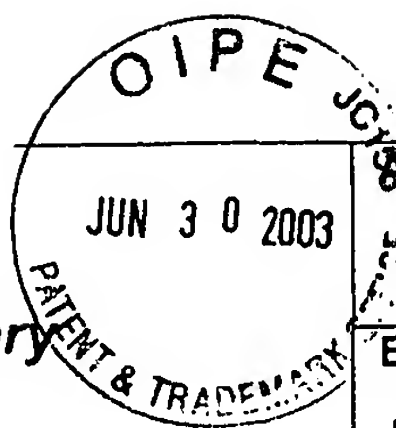
ART UNIT PAPER NUMBER

1634

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**



Application No.

10/049,994

Applicant(s)

CHAPARIAN ET AL.

Examiner

Juliet C. Switzer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

**Notice of References Cited**

Application/Control No.

10/049,994

Applicant(s)/Patent Under

Reexamination

CHAPARIAN ET AL.

Examiner

Juliet C. Switzer

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Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,728,561	03-1998	Denoya, Claudio D.	435/190
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-4, 7-9, and 15-16, drawn to method of cloning.

Group 2, claim(s) 5-6, drawn to a primer.

Group 3, claim(s) 10-11, 12-13, 14, and 17-18, drawn to genes and a library said genes.

If group 2 is elected applicant must further elect a single primer from those recited in Table I. Applicant should identify the page number of the specification reciting the primer as well as the SEQ ID NO of the elected primer.

If group 3 is elected applicant must further elect a single set of genes for prosecution. Upon election applicant should identify the page number of the specification reciting the genes elected as well as the SEQ ID NO of each gene.

2. The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The method of claim 1 is anticipated in the prior art, see US 5728561 which provides A method of targeted cloning and enrichment of genes and gene clusters by: directly isolating and subsequent cloning the targeted genes/cluster, as recited in claim 1 (Col. 9, lines 30-65). Thus, there is no special technical feature that joins the methods of group 1 and the products of group 2.

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3. The individual nucleic acids of groups 2 and 3 are not joined by a special technical feature because they do not share a common sequence or structure.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reason(s): the application recites a multiplicity of nucleic acid sequences that are not identified by proper sequence identifiers and there is no sequence listing in computer readable form or in paper copy present in the application.

In order to comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825), Applicant must submit a new CRF and paper copy of the Sequence Listing containing these sequences, in addition to the previously listed sequences, an amendment directing the entry of the Sequence Listing into the specification, an amendment directing the insertion of the SEQ ID NOs into the appropriate pages of the specification and a letter stating that the content of the paper and computer readable copies are the same.

4. A telephone call was made to Kenneth Kohn on 5/19/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the



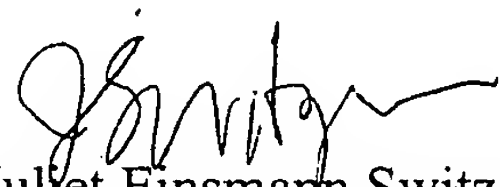
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet Einsmann Switzer whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Juliet Einsmann Switzer  
Examiner  
Art Unit 1634

June 2, 2003

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600